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### **REMARKS**

Claims 1-10 are pending and stand rejected, and with claims 11-20 withdrawn by provisional election, said provisional election is hereby affirmed and said withdrawn claims are herewith canceled without prejudice or disclaimer as to the subject matter thereof.

Applicants herewith tender new claims 21-35 for examination on the merits. Applicants note that these new claims relatively closely parallel independent claim 1 and claims depending therefrom so that all said claims can be readily examined at the same time. Independent claims 21 and 28 set forth claims directed to the inventive apparatus except in the form of signal producing media and a method, respectively.

### **Claim Rejections Under 35 U.S.C. §102(b)**

Claims 1, and 4-10 stand rejected as anticipated by U.S. Pat. No. 5,003,975 (the '975 patent) and claims 1-10 stand rejected as anticipated by U.S. Pat. No. 5,607,455 (the '455 patent).

As is well known and has been repeatedly reasserted by the federal courts, "[a] patent is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention. Lewmar Marine, Inc. v. Barient, Inc., 827 F.2d 744, 747 (Fed. Cir. 1987). Moreover, a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991). Patent law nonetheless establishes that a prior art reference which expressly or inherently contains each and every limitation of the claimed subject matter anticipates and invalidates. See, e.g., EMI Group N. Am., Inc., v. Cypress Semiconductor Corp., 268 F.3d 1342, 1350 (Fed. Cir. 2001) ("A prior art reference anticipates a patent claim if the reference discloses, either expressly or inherently, all of the limitations of the claim."); Verdegaal Bros., Inc. v. Union Oil Co. of

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Cal., 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.").

Applicants respectfully assert that the independent claim 1 as amended herein (as well as the new independent claims 21 and 28) include limitations not present in either the '975 patent or the '455 patent, either expressly or by principals of inherency. That is, since independent claim 1 cannot be found to be anticipated by the '975 patent the claims depending therefrom (specifically including claims 4-10) also cannot be said to stand anticipated.

With respect to the IDS recently submitted for review by the Examiner, Applicants intend to attempt to locate and forward the material(s) corresponding to the invalid URL, and prepare the foreign reference documents according to the requirements of 37 CFR §1.98, in due course.

Applicants respectfully suggest that the application as amended is in condition for allowance and earnestly solicit a Notice of Allowance so that the claimed subject matter may pass to timely issuance as U.S. Letters Patent.

The Examiner is invited to contact the undersigned with respect to this Preliminary Amendment and any matter related to the above-captioned patent application.

Date:

*2 Sept. 04*

Respectfully submitted,

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